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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,322	04/12/2000	Albert L. Donaldson	110768-00102	6262

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BLANK ROME LLP  
600 NEW HAMPSHIRE AVENUE, N.W.  
WASHINGTON, DC 20037

EXAMINER
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CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,322

Applicant(s)

DONALDSON, ALBERT L.

Examiner

Jason D. Cardone

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-85 is/are pending in the application.
- 4a) Of the above claim(s) 46-51, 53-57, 61-72 and 76-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44, 45, 52, 58-60 and 73-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/16/4, 12/21/4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's election of Group V in the reply, filed on February 2, 2005, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The argument of including Group VIII into Group V is not found persuasive because Group VIII deals with verifying addresses (709/244: centralized control routing), while Group V deals with selectively accepting emails (709/206: demand messaging).

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 46-51, 53-57, 61-72, and 76-85 are drawn to an invention nonelected without traverse in reply, filed on February 2, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. Claims 44, 45, 52, 58-60 and 73-75 are presented for further examination.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 73-75 are rejected under 35 U.S.C. 101 because claims 73-75 are not limited to tangible embodiments. In view of Applicant's disclosure, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., an article of manufacture) and intangible embodiments (e.g., a computer-readable medium having stored thereon instructions). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 73-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose a computer-readable medium having stored thereon instructions.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 44, 45, 52, 58-60 and 73-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Drummond et al. ("Drummond"), USPN 6,691,156.

11. Regarding claims 44, 58 and 73, Drummond discloses a system for selectively accepting an electronic message having a sender address and sent from a remote host to one or more recipient addresses [Drummond, col. 1, lines 13-26 and col. 4, lines 1-37], the system comprising an address verification filter determining whether the sender address exists and accepting the electronic message if the sender address exists [Drummond, col. 6, lines 10-60].

12. Regarding claims 52, 59 and 74, Drummond further discloses the address verification filter not accepting the electronic message if the sender address is determined not to exist [Drummond, col. 6, lines 27-60].

13. Regarding claims 45, 60 and 75, Drummond further discloses the address verification filter establishing a test connection from the system to an authorized mailhost for the sender address, sending a test transaction specifying the sender address to the authorized mailhost, and determining if the authorized mailhost affirmatively accepts the sender address as a recipient [Drummond, col. 6, lines 27-60 and col. 7, line 63 – col. 8, line 21].

14. Claims 44, 45, 52, 58-60 and 73-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Leeds, USPN 6,393,465.

15. Regarding claims 44, 58 and 73, Leeds discloses system for selectively accepting an electronic message having a sender address and sent from a remote host to one or more recipient addresses [Leeds, col. 6, lines 36-65], the system comprising an address verification filter determining whether the sender address exists and accepting the electronic message if the sender address exists [Leeds, col. 4, lines 37-59, col. 5, lines 7-57 and col. 8, lines 1-12].

16. Regarding claims 52, 59 and 74, Leeds further discloses the address verification filter not accepting the electronic message if the sender address is determined not to exist [Leeds, col. 4, lines 37-59 and col. 8, lines 1-12].

17. Regarding claims 45, 60 and 75, Leeds further discloses the address verification filter establishing a test connection from the system to an authorized mailhost for the sender address, sending a test transaction specifying the sender address to the authorized mailhost, and determining if the authorized mailhost affirmatively accepts the sender address as a recipient [Leeds, col. 4, lines 37-59 and col. 5, line 63 – col. 6, line 51].

### ***Conclusion***

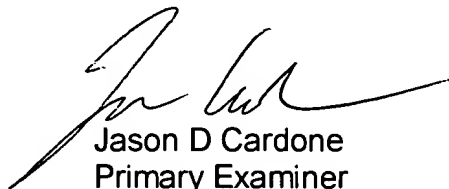
18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone  
Primary Examiner  
Art Unit 2145

April 25, 2005